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**Filed** : December 26, 2001

### **REMARKS**

Claims 22-26 and 28-30 are pending and stand rejected by the Examiner. Claims 22-26 and 28-30 have not been amended and remain presented for examination. Applicants respond below to the specific rejections raised by the Examiner in the Office Action mailed April 16, 2007. For the reasons set forth below, Applicants respectfully traverse.

#### **Rejection under 35 U.S.C. § 102(a)**

The Examiner has maintained the rejection of Claims 22-26 and 28-30 set forth in the final Office Action mailed August 18, 2006, as allegedly being anticipated under 35 U.S.C. § 102(a) by WO 99/58660 to Ruben et al. ("Ruben I"), published November 18, 1999. In the final Office Action, the Examiner argued that Ruben I teaches an amino acid sequence (SEQ ID NO: 131) that is 99.6% identical to SEQ ID NO: 57 of the instant application, and discloses epitopes along the entire length of the protein which can be used for the production of antibodies. Therefore, the Examiner argued that Ruben discloses each and every element of the rejected claims.

The Examiner also argued that the Declaration Under 37 C.F.R. § 1.131 submitted with Applicants' *Amendment and Response* filed October 17, 2006, in conjunction with the disclosure in Applicants' related application U.S.S.N. 60/130,359, is insufficient to antedate Ruben I. According to the Examiner, the Declaration establishes that Applicants were in possession of the polypeptide of SEQ ID NO:57 prior to Ruben I, but not of the antibodies to the polypeptide of SEQ ID NO:57. The Examiner argues that Ruben I teaches antibodies to SEQ ID NO: 57, yet the declaration does not show possession of claimed antibodies. The Examiner therefore concludes that the declaration does not teach as much as Ruben I. The Examiner also maintains that Applicants' demonstration of possession of polypeptides of SEQ ID NO: 57 and description of antibodies that bind thereto in U.S.S.N. 60/130,359 does not constitute evidence of possession of the antibodies, even though the Examiner states "the examiner does not question whether the best mode and written description criteria are met for the case of monoclonal antibodies, nor is there any doubt that the provisional application teaches how to make the monoclonal antibodies," *Office Action mailed August 18, 2006* at 4. In particular, the Examiner does not agree with Applicants' position that Example 16 of the Written Description Guidelines demonstrates that

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possession of a protein coupled with contemplation of antibodies that bind thereto is sufficient to establish possession of the antibodies.

Applicants submit herewith a Third Declaration Under 35 U.S.C. § 1.131 by Goddard et al. The Declaration sets forth facts which establish that, prior to November 10, 1999, the claimed antibodies and the proteins to which the claimed antibodies bind were conceived and reduced to practice. Specifically, as evidenced by the provisional application and the sequence printout annexed to the Third Declaration, Applicants were in possession of the complete coding sequence, the complete amino acid sequence, and antibodies that bind to SEQ ID NO: 57 prior to April 21, 1999. U.S. Patent and Trademark procedures provide that actual reduction to practice of a polypeptide antigen, coupled with contemplation of antibodies to that antigen, is sufficient to establish support under 35 U.S.C. § 112, first paragraph, for claims to the antibodies. *See, Written Description Guidelines*, Example 16: Antibodies. According to the PTO:

Considering the routine art-recognized method of making antibodies to fully characterized antigens, the well defined structural characteristics for the five classes of antibody, the functional characteristics of antibody binding, and the fact that the antibody technology is well developed and mature, one of skill in the art would have recognized that the spectrum of antibodies which bind to antigen X were *implicitly disclosed as a result of the isolation of antigen X*. (Emphasis added).

The facts of the instant case are analogous to Example 16. Applicants demonstrated, and the Examiner concedes, that Applicants were in possession of SEQ ID NO: 57 prior to the effective date of Ruben I. Applicants had also contemplated antibodies to SEQ ID NO: 57 prior to Ruben I, as evidenced by U.S.S.N. 60/130,359, and the Third Declaration under 35 U.S.C. § 1.131. Accordingly, under the *Written Description Guidelines*, SEQ ID NO: 57 and antibodies that bind thereto were reduced to practice on a date prior to November 10, 1999.

The Third Declaration under 35 U.S.C. § 1.131 unambiguously demonstrates that Applicants were in possession of at least as much of the claimed invention as the cited art, prior to November 10, 1999. The well-established "Stempel Doctrine" stands for the proposition that a patent applicant can effectively swear back of and remove a cited prior art reference by showing that he or she made that portion of the claimed invention that is disclosed in the prior art reference. (*In re Stempel*, 113 USPQ 77 (CCPA 1957)). In other words, a patent applicant need not demonstrate that he or she made the entire claimed invention in order to remove a cited prior

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art reference. He or she need only demonstrate prior possession of that portion of his or her claimed invention that is disclosed in the prior art reference and nothing more.

According to the Examiner, SEQ ID NO: 131 of Ruben I is greater than 99% identical to Applicants' SEQ ID NO: 57. Ruben I teaches that SEQ ID NO: 131 is expressed in brain tissue, hypothalamus, frontal cortex, cerebellum, amygdale, and hippocampus tissues. *Ruben I*, at p. 49, lines 1-5. Based upon the expression profile, Ruben I speculates that the polypeptides can be used as reagents for differential identification of tissue types of biological samples. Ruben I does not disclose the actual production of antibodies to SEQ ID NO: 131, however, based on sequence analysis, discloses potential epitopes along the protein. In other words, Ruben I merely contemplates antibodies to SEQ ID NO: 131. Applicants' Third Declaration under 37 C.F.R. § 1.131 establishes that Applicants were in possession of SEQ ID NO: 57, including a substantial and specific utility for the protein, prior to the effective date of Ruben I. The Third Declaration under 35 U.S.C. § 1.131, as well as U.S.S.N. 60/130,359, unambiguously demonstrate that Applicants had contemplated antibodies that specifically bind SEQ ID NO: 57 prior to Ruben I. As such, the evidence clearly shows that Applicants were in possession of at least as much of the claimed invention as Ruben I, prior to the cited reference. Because Applicants demonstrated, by means of the Declarations under 37 C.F.R. § 1.131 and the disclosure in their provisional application filed April 21, 1999, that they were in possession of so much of the claimed invention as is disclosed in Ruben I prior to the publication date of this reference, Applicants respectfully submit that this reference is not available as prior art.

Accordingly, in view of the above, Applicants respectfully request that the rejections under 35 USC §102(a) be withdrawn.

#### **Rejection Under 35 U.S.C. § 102(e)**

The Examiner has also maintained the rejection of Claims 22-25 and 28-29 as allegedly being anticipated under 35 U.S.C. § 102(e) by U.S. Patent Application Publication No. 2003/0100051 to Ruben et al. ("Ruben II"), with an effective filing date of November 10, 1999. The Examiner argues that the Second 1.131 Declaration is not sufficient to overcome the rejection over Ruben II under 35 U.S.C. § 102(e) for the same reasons that the Examiner found that Applicants had not overcome the rejection over Ruben I, above.

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Under the same reasoning set forth in the discussion of the rejection under 35 U.S.C. § 102(a), the Third 1.131 Declaration demonstrates that Applicants were in possession of the claimed invention prior to the publication date of Ruben II, and were certainly in possession of at least as much of the claimed invention as the cited reference. Therefore, Applicants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. § 102(e).

**Rejection Under 35 U.S.C. § 103(a)**

The Examiner has rejected Claims 22-26 and 28-30 as allegedly being unpatentably obvious over Ruben II in view of Holmes (1995), *Current Protocols Mol. Biol.* pp. 5.35-5.3.8 ("Holmes"). As discussed above in connection with the rejection under 35 U.S.C. § 102(e), the Examiner maintains that Ruben II teaches antibodies and antibody fragments that bind to SEQ ID NO:57. The Examiner also maintains that Holmes teaches conjugation of multiple labels to antibodies for the purpose of detection. According to the Examiner, it would have been obvious to one skilled in the art to label the antibodies or antibody fragments of Ruben II for the purposes of detecting PRO4380.

As discussed above, the Third 1.131 Declaration and US 60/130,359 establish that Ruben II is not prior art under 35 U.S.C. § 102(e), and as such cannot be relied upon to support a rejection under 35 U.S.C. § 103(a). Applicants submit that the rejection under 35 U.S.C. § 103(a) is improper.

In view of the above, Applicants respectfully request that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 103(a).

**CONCLUSION**

In view of the above amendments and remarks, Applicants respectfully maintain that the claims are patentable and request that they be passed to issue. Applicants invite the Examiner to call the undersigned if any remaining issues may be resolved by telephone.

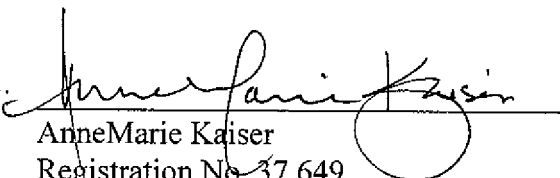
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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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